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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,836	11/03/2003	Michael T. Rossides		5759

7590
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12/18/2008

EXAMINER

RETTA YIHDEGA

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

12/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/700,836

Applicant(s)

ROSSIDES, MICHAEL T.

Examiner

Yehdega Retta

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are REJECTED.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recited "(a) a seller process for entering into the computer an offer stipulating that recipients who accept the offer will be owed a specified amount of money if they pay attention to a specified ad message, and if they satisfy a set of at least one target audience characteristics". Since the claim recites an intended use "a seller process", i.e., the seller process is for entering information, it is unclear what exactly the seller is entering in the computer and it is also unclear if the seller is actually enters information in the computer. The claim does not positively and clearly indicate that the seller enters the information in the computer and it does not clearly indicate what information is entered by the seller. The claim also recites "a recipient process" for registering acceptance of said offer by a user, which does not clearly recite the recipient registering acceptance also unclear how the recipient process entails the registration of the recipient identity or registering entering a request. In other words it is unclear what step is taken by the "a recipient process".

The claim also recites "and if they satisfy a set of at least one target audience characteristics" said characteristics states as a set of offer conditions by said advertiser". It is unclear how the target audience characteristics is related to "a set of offer condition". Is the set of offer condition indicated in the offer entered by the seller? It is also unclear who is considered to be a decision maker who influences a purchase and how the target audience characteristic is related to the recipient being a decision maker. Is a specific target audience considered a decision maker?

Applicant need to clearly specify what is the difference between an expected value (EV) and a "Payoff".

Claim 1 recites the limitation "said characteristics states as a set of offer condition by **said advertiser**". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz 6,298,330 in view of Walker et al. U.S. Patent No. 6,086,477 and further in view of Vance U.S. Patent No. 6,267,672.

Regarding claim 1, Gardenswartz teaches (a) entering into the computer an advertiser offer that said recipients will be owed an amount of money if they pay attention to a specified ad message, and if they satisfy a set of at least one target audience characteristics (the value contract is a promotional incentive in which the consumer is offered a reward for complying with a particular behavioral pattern such as a predefined change in behavior or the continuance of an established behavior); (b) stating said characteristics as a set of offer conditions by said advertiser, (c) specifying said amount of money as an expected value (EV), said EV to be paid via an EV payment bet including a Payoff, (d) presenting an interface to the public for enabling anyone to access and accept said offer, (e) registering acceptance of said offer by a user called a recipient, said acceptance entailing: registering the recipient's identity (see col. 14 line 54 to col. 15 line 45). Walker teaches paying expected value including a payoff to players (see col. 9 line 1 to col. 10 line 48). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Gardenswartz's reward and Walker lottery system, since randomly selecting winners and paying expected value of the award to selected ones reduce the outcome of

bets or winners. Therefore, one would be motivated to provide chance of winning to all participants and paying Expected value to only selected winner in order to reduce the outcome. Both Gardenswartz/Walker failed to teach inspecting winners, if they satisfy offer condition, it is taught in Vance. Vance teaches winners submit information prior to receiving the prize (see col. 6 lines 34-54). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Gardenswartz's value contract offer and Walker's payment of expected value and Vance verification of winners, in order to prevent dishonest consumers from fraudulently claiming prizes, as taught by Vance (see col. 6 lines 34-54).

Examiner would like to point out that even though all the limitation have been addressed, it has been held that Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C). The claim recite executing EV payment bet and *if and only if the recipient wins a bet* passing the wining result to an inspection process, which means that if the recipient does not win the bet the rest of the claim is not performed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622